

REMARKS

Entry of this Amendment, reconsideration and allowance of the above-captioned patent application are respectfully requested. This application relates to N-benzyl aminoalkylcarboxylates as edg receptor agonists.

Claims 1 to 34 and 47 are currently pending in the application. Claims 1 to 7, 9, 11 to 13, 20 to 23 and 47 are objected to as containing non-elected subject matter. Claims 23 and 28 are objected to as not ending in a period. Claims 8, 10, 14 to 19 and 29 to 34 have been withdrawn from consideration. Claim 47 has been provisionally rejected for obviousness-type double patenting over Claims 23 and 24 of co-pending Application No. 10/501,176. Claims 1 to 7, 9, 11 to 13, 20 to 28 and 47 have been rejected as obvious over WO 01/38325 ("Takeda"). No claim has been allowed.

This Amendment amends Claims 1, 2, 9, 21 and 28 and cancels Claims 3, 8, 10 to 19, 23 and 29 to 33 and 47. Objections and/or rejections pertaining to canceled claims are rendered moot. In particular, Applicants have canceled Claim 47 in order to advance prosecution of the captioned patent application and such cancellation is not an admission that Claim 47 is unpatentable. Applicants reserve the right to prosecute all excluded and canceled subject matter in one or more future divisional applications. Upon entry of this Amendment, claims in the application will be Claims 1, 2, 4 to 7, 9, 21, 22, 24 to 28 and 34.

As result of this Amendment, Claims 1, 2, 4 to 7, 9, 21, 22 and 24 to 28 are drawn solely to Group VI subject matter, thereby overcoming the Examiner's objection. As Claim 34 depends from an allowable product claim, Applicants respectfully request that Claim 34 be rejoined pursuant to M.P.E.P. § 821.04.

A period has been added at the end of Claim 28. Language directed to pharmaceutically acceptable salts has also been added. Support for this change can be found, for example, at page 28, line 12 to page 29, line 5.

Applicants respectfully traverse the rejection of Claims 1, 2, 4 to 7, 9, 21, 22 and 24 to 28 as obvious over Takeda. There is no teaching, suggestion or motivation provided by Takeda that would lead one skilled in the art to the presently claimed invention. Takeda teaches

a vast genus of compounds described as a Markush group at page 3. One skilled in the art starting from the genus described in Takeda would have to make numerous modifications based on the various alternatives taught in the specification and/or combine various pieces from the 346 examples to construct the compounds of the present invention, without any teaching, suggestion or motivation to do so.

First, starting from the genus taught in Takeda, one skilled in the art would have to select pyrrolidine for the ring B out of the 20 possibilities listed at page 28, **even though none of the 346 examples contain a pyrrolidine at this position.** In fact, the examples are mainly directed to compounds having a pyrrole or pyrazole at this position, which are aromatic groups and thus have different properties than a non-aromatic group such as pyrrolidine. Even the Examiner's restriction requirement of March 1, 2007 distinguishes between the various heterocyclic groups as patentably distinct.

Second, one skilled in the art starting with Takeda would have to select thienyl for the variable R¹, which is defined as "a hydrocarbon group that may be substituted or a heterocyclic group that may be substituted." The definition of R¹ then continues on page 8 and spans the next 17 pages. Thienyl is listed among a long list of heterocyclic groups at page 11. Only four out of the 346 examples include thienyl for R¹ (Exs. 19 to 22), and of these all are propionic acids instead of carboxylic acid derivatives. Furthermore, none of these examples are substituted.

Third, one skilled in the art would have to select the specified substituents of the present invention on the thienyl group from the vast list in Takeda spanning pages 12 to 23.

Fourth, one skilled in the art would have to select W to be -CH₂- from the list at page 33, even though the majority of the actual examples are propionic acid derivatives. Furthermore, Claims 24 to 28 are directed to carboxylic acid derivatives which are not within the scope of Takeda's Formula I. See the definition of W at page 4.

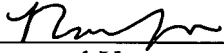
Based on the foregoing, Applicants submit the Examiner has engaged in impermissible hindsight to reject the instant claims as obvious. After the fact, one can readily go back and select the various alternatives to read on portions of the present invention. However, at

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the time the invention was made, one skilled in the art would in no way have been motivated to select the particular alternatives out of the extremely large and complicated genus of Takeda to arrive at the present invention. Therefore, the instant claims are in no way obvious over Takeda and withdrawal of the obviousness rejection is respectfully requested.

Applicants submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Amendment may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

By 
Raynard Yuro
Reg. No. 45,570
Attorney for Applicants

MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-0182

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